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MAY 13 2005

In re Application of	:	OFFICE OF PETITIONS
Smith et al.	:	
Application No. 08/392,934	:	DECISION
International Filing Date:	:	ON PETITION
September 15, 1993	:	
Attorney Docket Number: 01-3033	:	
371 Date: October 28, 1996	:	
Title of Invention:	:	
IMMUNOREACTIVE PEPTIDES FROM	:	
EPSTEIN-BARR VIRUS	:	

This is a decision in response to the Request for Reconsideration of Petition Under 37 CFR 1.137(b), filed February 7, 2005.

This Petition is hereby granted.

Background:

Applicants filed a Request for Continued Examination (RCE) under 37 CFR 1.114 on December 18, 2001, in the above-identified application, which is the National Stage of an International Application filed on September 15, 1993. The RCE was improper because the provisions of 37 CFR 1.114 do not apply to an international application filed under 35 U.S.C. 363 before June 8, 1995. See 37 CFR 1.114(e)(3).

A request for continued examination is not a type of new application filing. See Request for Continued Examination Practice and Changes to Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092, 50097 (August 16, 2000). The Office cannot convert an improper RCE to an application, such as a continuing application under 37 CFR 1.53(b) or (d). An improper RCE will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application. See Manual for Patent Examining Procedure (MPEP) 706.07(h), page 700-70, subsection III.A., "Treatment of Improper RCE", (8th Ed. 2001).

In the instant case, a final Office action was mailed on June 28, 2001. Under 35 U.S.C. § 133, an applicant has six (6) months to reply to an Office action. Upon failure to prosecute the application within six months of notice of the Office action, the application shall be regarded as abandoned. This statutory requirement may not be waived by the Office. The filing of the improper RCE on December 18, 2001, did not toll the time period set forth in the Office action mailed on June 28, 2001. Thus, the application became **abandoned** on **December 29, 2001** for the failure to reply to the final Office action mailed on June 28, 2001.

The Office, however, mistakenly treated the improper RCE as a proper RCE and reopened the prosecution of the application. A Supplemental Response was filed December 18, 2001. A non-final Office action was mailed on March 8, 2002. A reply to the non-final Office action was filed on August 12, 2002. An Ex Parte Quayle action was mailed October 29, 2002. An amendment in response to the Ex Parte Quayle action was filed on December 2, 2002. A Notice of Allowance was mailed on February 20, 2003.

Applicants were advised in a Notice Regarding Improper RCE, mailed November 5, 2004, the RCE was improper, and advised to file a petition under 37 CFR 1.137(b) and a terminal disclaimer and fee as set forth in 37 CFR 1.321 because the application was filed before June 8, 1995.

Applicants filed a petition to revive the application based upon unintentional abandonment of the application on November 3, 2004. The petition was dismissed in a Decision mailed December 9, 2004, for failing to meet the requirements of a grantable petition under 37 CFR 1.137(b).

The instant petition

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after the applicant becomes aware of the abandonment and must be accompanied by: (1) the required reply, unless previously filed, (2) the petition fee required by law, (3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional", and (4) a terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) is required pursuant to paragraph (c) of this section (for applications filed before June 8, 1995).

Applicants have satisfied Items (1) through (4). With regard to subsection (4), since the above-identified application is a utility application filed before June 8, 1995, 37 CFR 1.137(c) requires a terminal disclaimer dedicating to the public a terminal part of any term of any patent granted on the above-identified application or any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the above-identified application. The period to be disclaimed will be a terminal part of the patent to be granted equivalent to the period of abandonment. The period of abandonment will be computed to be the number of months lapsed from the date of abandonment to the date when this application issued as a patent. A Terminal disclaimer fee of \$130 is required and has been provided. The Terminal Disclaimer filed on February 7, 2005 has been accepted.

All of the requirements of 37 CFR 1.137(b) have now been met. Accordingly, applicants' petition to revive is granted.

The application is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.


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Petitions Attorney
Office of Petitions